

DIPOSITION
IS NOT CITABLE
AS PRECEDENT
OF THE TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513

az

Mailed: February 12, 2003

Cancellation No. 24,108

Galleon S.A., Bacardi-
Martini U.S.A., Inc., and
Bacardi & Company Limited

v.

Havana Club Holding,
S.A., dba HCH, S.A., and
Empresa Cubana Exportador
De Alimentos y Productos
Varios, S.A., dba
Cubaexport, joined as a
defendant

Albert Zervas, Interlocutory Attorney

On January 21, 2003, the Board inter alia joined respondent Empresa Cubana Exportador De Alimentos y Productos Varios, S.A. ("Cubaexport") as a party to this proceeding and reset the time for respondents to respond to petitioners' summary judgment motion (filed March 15, 2002).

On February 5, 2002, Martin Leroy of the law firm of Fish & Neave left a telephone message with the Board, requesting a telephone conference on Cubaexport's behalf for an extension of time to respond to petitioners' summary judgment motion. At the Board's instruction, Mr. Leroy filed a request via facsimile for the extension and

telephone conference the next day. In the following days, the Board received several papers via facsimile from the parties, namely; (a) petitioners' response (filed February 7, 2002) objecting to the extension; (b) respondent Havana Club Holding, S.A.'s ("HCH") response (filed February 10, 2002) consenting to the extension; (c) HCH's amended response (also filed February 10, 2002); and (d) Mr. Leroy's reply (filed February 10, 2002) to petitioners' response.¹ The Board also received a communication from petitioners on February 7, 2002 regarding their counsel's unavailability for a telephone conference.

Because the parties have filed papers which substantively and suitably address the merits of Mr. Leroy's request for an extension of time, the Board concludes that a telephone conference is unnecessary and that the Board can decide the request for an extension of time. Mr. Leroy's request for a phone conference is therefore denied.

Mr. Leroy maintains that Cubaexport is a Cuban enterprise whose office are in Havana, Cuba; and that "certain transactions involving property in which Cuba or a national thereof has an interest are prohibited except as

¹ The papers filed by Fish & Neave and HCH do not show proper proof of service in accordance with Trademark Rule 2.119(a). A "cc" designation -- which appears on such papers -- does not set forth the date and manner in which service was made, which is mandated by Trademark Rule 2.119(a). Strict compliance with Trademark Rules 2.119(a) and (b) is required in all papers filed in the future with the Board.

specifically authorized by the Secretary of the Treasury or the director of the Office of Foreign Assets Control ('OFAC').” He adds that Fish & Neave has submitted an application for a specific license with OFAC to represent Cubaexport in this cancellation proceeding;² and that “[w]ithout the specific OFAC license Fish & Neave has sought, this firm cannot be paid for services performed for Cubaexport in connection with the proceeding,” citing *American Airways Charter v. Reagan*, 746 F.2d 86 (DC Cir. 1984), which states that “no fee can be paid counsel absent a separate and express, authorization from OFAC.” Further, Mr. Leroy argues that if OFAC grants a specific license, “Fish & Neave will require additional time to obtain the complete file ... becom[e] familiar with the extensive history and legal issues in this 7-year old matter, [address] with counsel for HCH prior proceedings here, ... coordinate[e] efforts with counsel for HCH in the cancellation proceeding” and that “[i]t may be necessary to travel to Cuba to meet with representatives of Cubaexport.”

Petitioners inter alia maintain that “Fish & Neave is not barred from representing a Cuban national by the OFAC regulations,” citing *American Airways Charter v. Reagan*, 746

² Fish & Neave has requested expedited consideration of its application.

F.2d 86 (DC Cir. 1984) which states that OFAC "lacks authority to condition the bare formation of an attorney-client relationship on advance government approval."

Petitioners also argue that an "extension would result in inordinate delay by providing Cubaexport with nearly fifteen months to respond to" petitioners' summary judgment motion and that "Cubaexport and its counsel of record have already had Bacardi's papers for over eleven months and have been aware of Bacardi's arguments for over five years ..."

The standard to be met to extend a time frame is "good cause". See Fed. R. Civ. P. 6(b). See also, TBMP §509, and cases cited therein.

In determining whether good cause has been shown, the Board notes that it is in the interest of the Board that Cubaexport retain adequate counsel who remains as Cubaexport's counsel for the duration of this proceeding. To achieve this, arrangements must be made for the payment of counsel's fees. In view thereof, and because *American Airways, supra*, allows OFAC to require authorization so that counsel may be paid a fee, because petitioners have not disputed that Fish & Neave may not be paid absent a specific license from OFAC, and because Cubaexport evidently intends that Fish & Neave represent Cubaexport as its counsel in

this proceeding,³ the Board finds that good cause has been shown for extending the time for Cubaexport to respond to petitioners' summary judgment motion. Also, petitioners' argument that an "extension would result in an inordinate delay" is not well taken; Cubaexport was only joined as a party to this proceeding roughly three weeks ago.⁴ Thus, Mr. Leroy's request to extend time is granted to the extent that proceedings are suspended pending a decision by OFAC on Fish & Neave's application for a specific license to represent Cubaexport in this proceeding.⁵ Cubaexport is ordered to inform the Board of the grant or denial of Fish & Neave's application, and to file a copy of OFAC's decision, within **two business days** from the date Fish & Neave receives notification from OFAC of the grant or denial of its application.

³ Fish & Neave, which is not a stranger to this Board, has spent the time and effort in applying for a specific license from OFAC to represent Cubaexport and in requesting additional time to respond to petitioners' summary judgment motion. The Board is satisfied that Cubaexport intends Fish & Neave to act as its counsel in this proceeding.

⁴ Petitioners have raised a number of arguments which are not repeated in this order. The Board has considered each of petitioners' arguments and has found them to be unpersuasive. (Some of these arguments are just plain wrong, e.g., "Mr. Krinsky was identified [in the Board's January 21, 2003 order] as Cubaexport's counsel of record in this proceeding.")

⁵ The Board has not merely reset the time for Cubaexport to respond to the summary judgment motion [as requested by Mr. Leroy] because the record does not reflect that OFAC must render a decision on Fish & Neave's application within a particular time period, e.g., one week or two months or longer. To guess (possibly incorrectly) at a date by which OFAC may act could result in another motion to extend time.

Cancellation No. 24,108

If Fish & Neave's specific license is granted and if otherwise appropriate, the Board will reset the time for Cubaexport and HCH to respond to petitioners' summary judgment motion.

To expedite matters, a copy of this order is being sent via facsimile as well as by first class mail.

cc:

William Golden, Jr.
Kelley Drye & Warren LLP
101 Park Avenue
New York, NY 10178
Facsimile No. 212-808-7897

Charles Sims
Proskauer Rose LLP
1585 Broadway
New York, NY 10036
Facsimile No. 212-969-2900

Michael Krinsky⁶
Rabinowitz, Boudin, Standard,
Krinsky and Lieberman, P.C.
740 Broadway at Astor Place
5th Floor
New York, NY 10003-9518
Facsimile No. 212-674-4614

Martin Leroy
Fish & Neave
1251 Avenue of the Americas
New York, NY 20020
Facsimile No. 212-596-9096

⁶ Until the Board has been informed that OFAC has approved Fish & Neave's application, all notices and orders in this proceeding for Cubaexport will continue to be mailed to Mr. Krinsky and all papers to be served on Cubaexport pursuant to Trademark Rules 2.119(a) and (b) must be served on Mr. Krinsky. Mr. Krinsky of Rabinowitz, Boudin, Standard, Krinsky and Lieberman, P.C. is still identified as Cubaexport's domestic representative in the records of the United States Patent and Trademark Office. See Trademark Rule 2.119(d).